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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,877	10/11/2001	Daryl E. Anderson	10011728-1	2159

7590 09/12/2005

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EXAMINER

HESS, BRUCE H

ART UNIT PAPER NUMBER

1774

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,877

Applicant(s)

ANDERSON ET AL.

Examiner

Bruce H. Hess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

IDS

10/11/01, 7-16-02, 11-13-02, 3-17-03, 5-12-03, 5-15-03, 5-28-04 and 5/9/05

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

101-190

- 4) ☒ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____
- Paper No(s)/Mail Date 10/11/01, 7-16-02, 11-13-02, 3/17/03, 5-12-03, 5-15-03, 5/28/04 and 5-9-05

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Claims 101-190 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the enabling disclosure is limited to CD/DVD recording media having surface laser sensitive material employed for labeling purposes, not for the purpose of primary data storage.

Claims 101-190 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in the recital of "laser sensitive materials". It cannot be determined if the aforementioned materials are for primary data storage or labeling.

Claims 101-190 are rejected under 35 U.S.C. 102 (b) as being anticipated by applicants' statement of the prior art. Applicants acknowledge that the various "surface laser sensitive materials" disclosed in their specification are known as primary imaging materials in the recording arts. Since the claims broadly recite a "recording medium", the prior art imaging compositions anticipate all of the claims. It is noted this rejection can be overcome by limiting the claims to CD/DVD recording media having 1) primary image recording areas and 2) labeling surfaces which comprise the disclosed "laser sensitive materials".

Claims 101-190 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Yamaha (JP 2000330359) in view of applicants' statement of the prior art. Yamaha teach^{o'} applying a labeling area to the non-data side of a CD/DVD (see page 12 of the supplied translation). This labeling area employs conventional non-impact

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imaging material (e.g., color change, photosensitive and thermosensitive layers).

Applicants acknowledge in their specification that the various laser sensitive materials disclosed in their specification are known as non-impact recording materials.

Consequently, use of the acknowledged prior art recording material as the generically disclosed recording material of Yamaha would have been obvious to one of ordinary skill in this art in the absence of unexpected results.

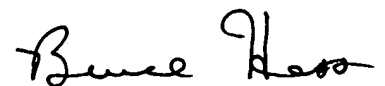
5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 101-190 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/235,155. Although the conflicting claims are not identical, they are not patentably distinct from each other because the "recording medium" of the instant claims is inclusive of the optical disc of S.N. 10/235,155.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



BH Hess

9/5/05

B. HAMILTON HESS
PRIMARY EXAMINER